

REMARKS

Claims 1-14 are pending in this application, of which claims 12-14 are withdrawn as being directed to a non-elected invention. Claim 1 is the sole independent claim.

Favorable reconsideration of this application, in light of the following remarks, is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-7 and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,820,329 ("Derbinski") in view of U.S. Patent No. 4,226,208 ("Nishida"). Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the Derbinski and the Nishida references, individually or in combination, fail to disclose or suggest, *inter alia*:

the housing halves under an action of a force-generating member is designed to be moved from a first position in which the housing halves, through tight, sealing contact with the revolver, prevent rotation thereof, to a second position in which the upper and lower housing halves are separated from the revolver in order to permit rotation of the latter to predefined positions.

In particular, Applicants submit that the Derbinski reference does not disclose or suggest housing halves 6, 7 being ***moved*** under an action of a force-generating member in a first position with the revolver, prevent rotation thereof, to a second position where the housing halves 6, 7 are separated from the revolver in order to permit rotation.

In an example, non-limiting embodiment, FIG. 2 illustrates the housing halves 6, 7 may be designed to assume either of two positions, in the first position of which the housing halves are in contact with the revolver 9, which is prevented from turning.

In the second position, the housing halves may be separated from the revolver 9, so as to be capable of rotating. Acting between the housing halves may be hydraulic members 12, such as, e.g., cylinders, which are designed to set the housing halves 6, 7 to the second position via a hydraulic force, illustrated by arrows 13. Furthermore, the upper and lower housing halves 6, 7 may be designed to return to the first position when the hydraulic force no longer acts on the housing halves 6, 7. The upper and lower housing halves 6, 7 may therefore be set to the first position under the action of atmospheric pressure, for example, illustrated by arrows 14, revealing that no external force has been supplied.

In the outstanding Final Office Action, the Examiner continues to reject claim 1 based on an assertion that the circular walls 12 and 13 correspond to the upper and lower housing halves, respectively, in Derbinski.¹ Applicants respectfully disagree, as argued in the previously filed Response of July 23, 2010, because the circular walls 12 and 13 are **not movable** with respect to each other – but instead, **stationary and permanently** connected, and not designed to be moved.

The Examiner, however, refutes Applicants' previously-made arguments by asserting that:

...each of the housing halves has been considered to include not only the outside surrounding structure, but also the structures found therein, as well. As **chamber covers 46 and 54 are in the upper housing half and the lower housing half, respectively**, they are considered parts thereof; and in rejecting the pending claims they are considered the parts thereof that are moved under an action of force generating member to a sealing contact with the revolver.²

In other words, the Examiner argues that since chamber covers 46 and 54 are considered to be “*part*” of the respective housing halves 12 and 13, the housing halves

¹ See Office Action mailed November 23, 2010, page 3, paragraph 5.

² See Office Action mailed November 23, 2010, page 8, paragraph 27.

are thus designed to be movable. Applicants respectfully disagree.

Applicants respectfully submit that this rejection is improper, and respectfully submit that the Examiner's interpretation of the Derbinski reference is unreasonable. It is improper for the Examiner to employ "**an unreasonable claim construction and a strained reference interpretation**" that is inconsistent with the reach of the claimed subject matter when given its broadest reasonable interpretation consistent with the subject specification as it would have been understood by one of ordinary skill in the art."³ In this case, in light of the specification, it is the "housing halves" that are moving under an action of a force-generating member in the first position to the second position. Just because there is a "movable" part(s) in Derbinski, it does not necessary mean it is moving. That is, *to move a "part" of an object is not the same as moving the object as such (e.g., opening a door of a car would not be considered moving the car as such).*

Furthermore, the Federal Circuit in In re Arkley⁴ stated:

The [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.

Moreover, the Federal Circuit in Therasense, Inc. and Abbott Laboratories v. Becton, Dickinson and Company, and Nova Biomedical stated:

The requirement that the prior art elements themselves be 'arranged as in the claim' means that claims cannot be 'treated . . . as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.' *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984).

³ see Ex parte Ma et al., Appeal No. 2010-3794 (BPAI 2010).

⁴ 455 F.2d 586, 587 (CCPA 1972).

In other words, the Examiner is *picking and choosing* various elements of Derbinski without considering the “relation” of the part(s). The Examiner cannot rely on a “separate” part of the machine and constitute as the ‘whole’ device. As rightly interpreted by the Examiner, the circular walls 12, 13 of Derbinski correspond to the “housing halves” because they are joined thereto and include the respective recesses to form the chambers, as taught by claim 1. Contrarily, the chamber covers 46, 54 do not contain either of the aforementioned features and, therefore, cannot be considered the “housing halves.”

Accordingly, the Examiner’s rejection is deficient because the cited elements are not arranged as required by claim 1. More specifically, because the cited elements relied upon are included in *disparate* disclosures of the cited reference which are “not directly related to each other,” it is submitted that the rejection is deficient as *impermissible* “picking and choosing” has occurred.

Finally, contrary to the Examiner’s assertion, the chamber covers 46 and 54 of Derbinski are not designed to be “movable” where the chamber covers are, in one position, prevented from rotating, and in another position, separated from one another to permit rotation, as taught by claim 1.

Derbinski, on the other hand, discloses that the chamber cover 46 (or 54) is merely actuated to move ***rightwardly*** as viewed in FIG. 3 into contact with the sealing ring 27, deflecting it against the back wall 13 of the chamber 11, and forming a sealed processing chamber 47 that is isolated form the main chamber 11. (see col. 4, lines 39-45 of Derbinski). There is no discussion that the movement of the chamber cover 46 (or 54) is to prevent/permit rotation. In other words, the chamber cover 46 is understood to be the force generating member in Derbinski that moves the chamber cover from a first non-contact position to a second sealed contact position with the

sealing ring, and not as in claim 1, “a force generating member moving housing halves from a first tight sealing contact position with the revolver, prevent rotation thereof, to a second position where the housing halves are separated from the revolver in order to permit rotation.” In other words, the device in Derbinski is disclosed to use force to create a chamber seal, whilst the device according to claim 1 is disclosed to use force to open a chamber seal (i.e., chambers are formed by the movement of the housing halves in contact with the revolver, and opened when housing halves are moved apart, away from the revolver).

Accordingly, Applicants respectfully submit that the Derbinski reference fails to disclose, or even suggest, “the housing halves under an action of a force-generating member is designed to be moved in least peripherally from a first position ... to a second positionin order to permit rotation of the latter to predefined positions,” as recited in claim 1.

In regard to the Nishida reference, Applicants submit that the Nishida reference does not remedy the deficiencies of Derbinski. In particular, the alleged housing halves in Nishida, that is, the base plate **74** and vessel **78** in contact with the rubber gasket 86, are in fixed positions and nothing is disclosed about them being movable in relation to each other. There are movable parts forming treatment containers/chambers in Nishida, and no housing halves being moved in relation to each other to form the treatment containers/chambers. Moreover, Nishida disclose that a bell jar 32 is pressed against the base plate 74 by hydraulic means when a chamber 64 is opened in order to retain vacuum in the container 76. (*see col. 3, lines 32-39*). As such, there is no housing half being moved, and the actuating force, is, as in Derbinski, used to create seal, not to open a seal as in the device of claim 1.

Furthermore, the Examiner asserts that the “gasket” **86** of Nishida corresponds to the “flexible sealing member” of claim 1. Applicants respectfully disagree because one skilled person in the art would not consider the gasket 86 of Nishida to have a “*joining effect*.” The gasket 86 appears only to have a sealing effect because of the selected construction of the device where the vessel 78 and base plate 74 form the vacuum container 76 and, therefore need to be mounted to each other in a sealed, vacuum tight manner. It is not employed as “under the action of a force-generating member being designed to be moved from a first position in which the housing halves, through tight, sealing contact with the revolver, prevent rotation thereof, to a second position in which the upper and lower housing halves are separated from the revolver in order to permit rotation,” as taught by claim 1.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 1.

Applicants respectfully submit, further, that the proposed combination of Derbinski and Nishida is improper. In order to establish a *prima facie* case of obviousness, the Examiner must establish that it would have been obvious for one of ordinary skill to have combined the teachings of the cited documents.⁵ For instance, the Examiner asserts that:

[i]t would have been obvious to one of ordinary skill in the art at the time the Applicant’s invention was made to have provided the upper and lower halves of the vacuum device in Derbinski et al. joined by a flexible sealing member in order to form a sealed vacuum container as taught by Nishida et al.⁶

⁵ See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. at 398, 82 USPQ2d at 1396 (2007).

⁶ See Office Action mailed November 23, 2010, page 4, paragraph 8.

However, it is well-settled law that the proper inquiry in determining obviousness is not whether two references can be combined, but rather whether one of ordinary skill in the art would desire to do so in order to arrive at the claimed invention.⁷ Further, it is submitted that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab.⁸ See also In re Lee ⁹ (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); and In re Fine.¹⁰

In the instant case, Applicants respectfully submit that, were it not for the teachings provided by the subject application, one of ordinary skill in the art would not be motivated to combine the teaching of the Derbinski reference with the teachings of the Nishida reference in the manner as proposed by the Examiner.

For instance, there is no suggestion in the reference that the embodiments in Derbinski and can be combined with the embodiments of Nishida. That is, Derbinski does not suggest, much less disclose, of combining the conventional gasket 86, sealing the base plate 74 and the vessel 78, of Nishida to arrive at the features of claim 1.

⁷ See, e.g., MPEP § 2143.01(III), which states "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination," citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

⁸ 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

⁹ 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

¹⁰ 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Hence, it is respectfully submitted that there is no suggestion for the desirability of the combination. Specifically, there is no motivation (and advantage) to move the housing halves 12, 13 of Derbinski. Instead, it appears that it is more advantageous to keep the housing halves 12, 13 stationary since that naturally enables a better seal - ***teaching away*** from such construction. As such, one skilled in the art would be discouraged to place the gasket between the housing halves of Derbinski, as the housing halves should be stationary.

Therefore, the rejection failed to articulate a proper rationale to support an obviousness rejection.

In view of the above, Applicants respectfully submit that one of ordinary skill in the art would not have combined the teachings of the Derbinski and the Nishida references in the manner used to reject the claims, and that the proposed combination of the Derbinski and the Nishida references fails to teach or suggest *all* of the elements of claim 1. Thus, no *prima facie* case of obviousness has been established. Accordingly, claim 1 is allowable over the Derbinski and the Nishida references. Dependent claims 2-7 and 9-11 depend from claim 1 and are allowable for at least the reasons that claim 1 is allowable. Therefore, Applicants respectfully request that the rejection of claims 1-7 and 9-11 under 35 U.S.C. § 103(a) be favorable reconsidered and withdrawn.

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Derbinski and Nishida and further in view of U.S. Patent No. 5,415,729 ("Strasser"). Applicants respectfully traverse this rejection for the reasons discussed below.

Claim 8 is believed to be allowable for at least the reasons set forth above regarding claim 1. The Strasser reference fails to provide the teachings noted above as

missing from the Derbinski and the Nishida references. Since claim 8 is patentable at least by virtue of its dependency on claim 1, Applicants respectfully request that the rejection of claim 8 under 35 U.S.C. § 103(a) be withdrawn.

Request for Interview

Applicants respectfully request, prior to the issuance of an action on the merits, that the Examiner grant an interview (telephonic or in-person) with Applicants' representative in order to discuss the Office Action, and the differences between the cited prior art and the subject matter cited in the claims.

Applicants' representative will telephone the Examiner in the near future in an attempt to schedule this interview. However, as Applicants' representative cannot anticipate when this action will be scheduled for further action by the Examiner, it is requested that the Examiner contact Applicants' representative by telephone, at the number given below should a specific date for the interview have not been scheduled when the Examiner takes this action up for further action. Every effort will be made to meet the Examiner's scheduling preference.

CONCLUSION

In view of the above remarks, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly,

Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

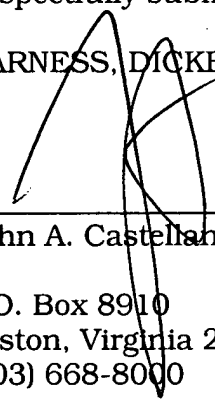
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,


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